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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,805	10/01/2001	Darrell T. McKenzie	DANA-139	3400

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EXAMINER

CECIL, TERRY K

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 04/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,805

Applicant(s)

MCKENZIE, DARRELL T.

Examiner

Mr. Terry K. Cecil

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-10 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 1-30-2003 is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

In view of the terminal disclaimer filed 1-30-2003, the double patenting rejection of the prior office action is withdrawn.

Specification

In view of the new abstract filed 1-30-2003, the objection to the abstract of the prior office action is withdrawn.

Drawings

Applicant's new formal drawing has obviated the drawings objections of the prior office action.

Claim Objections

1. Claim 1 is objected to because of the following informality: "and" should be added before "valve body" (claim 1, line 5). Appropriate correction is required.
2. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The limitation of claim 15 "wherein the unitary body is *made* of flexible resilient material" is synonymous with "a unitary body of flexible resilient material" of claim 1—as argued by the applicant (last paragraph of page 9 in the amendment filed 1-30-2003).

Claim Rejections - 35 USC ' 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-7 and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected because of the following reasons:

- the following terms lack antecedent basis: “the first section” (claim 11, lines 13 and 21; did applicant intend to claim “first *annular* section”?); “the body member” (claim 11, line 22; did applicant intend to claim “the unitary body”?); and “the valve body” (claim 11, line 25). *The aforementioned lack of antecedent bases was indicated for claim 11 in the prior office action (first bullet of section 7) but was not corrected in the amendment filed 1-30-2003;*
- claims 12-14 are rejected since they suffer the same defects as claim 11 from which they depend;
- in claim 2, line 1, “the filter element *and* valve support and valve” lacks antecedent basis (did applicant intend to claim “the filter element support and valve”?); and
- claims 3-7 and 15-16 are rejected since they suffer the same defects as claim 2 from which they depend.

Claim Rejections - 35 USC ' 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

Ascertaining the differences between the prior art and the claims at issue.

Resolving the level of ordinary skill in the pertinent art.

Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-7 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckman (U.S. 3,567,023) in view of Hultgren (U.S. 3,369,666). Buckman discloses a filter element support and valve comprising the following:

- a *unitary* valve body made of resilient flexible material (figure 7) that engages both the filter element and the end plate 10 and includes a bypass valve portion 24 and an anti-drainback portion 21 [as in claim 1] wherein the valve body is made of rubber [as in claims 15-17].

Buckman does not teach a clean side valve that is unitary with the valve body. However, Hultgren teaches a clean-side one-way valve [as in claim 1] which is part of a plural valve arrangement and comprises a plate 62 [as in claim 4], a purse valve [as in claim 6] opening away from the hollow core, and which includes a pair of lips intersecting along a line (figure 2)[as in claim 7]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the clean-side one-way valve of Hultgren as part of the plural valves of Buckman since Hultgren teaches benefits as explained in col. 1 of Hultgren below:

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The throwaway spin-on full flow oil filter unit also is provided with an anti-drain back valve or a one-way valve in order to prevent oil from the engine parts from leaking back through the filter housing to the oil reservoir or to the engine crank case when the engine is not operating, so that upon starting the engine later on, the engine parts will not be starved of oil and oil will immediately flow to properly lubricate the engine parts. 50

Upon modification, it would have been obvious to the skilled man for the clean side valve and plate thereof to be unitary with the valve body (figure 7) of Buckman and to be formed as part of the single rubber piece of Buckman, since Buckman teaches the desirability of few parts "to reduce the costs of manufacture and assembly" (col. 4, lines 42-46) [as in claims 1 and 5]. It would also have been obvious since it has been decided that the use of a one piece construction instead of the structure disclosed in the prior art (formed of more than one piece) would be merely a matter of obvious engineering choice. See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

As for claim 2, Buckman also teaches a filter element 7 having a hollow core 30, wherein the valve portions of the unitary body include annular sections (24 and the area of the valve body immediately above and attached to 24 extending along a minor portion of the area between the leaders of reference nos. 22 and 23 of figure 7) coaxially aligned with the hollow core (as shown in figure 1); wherein the upper annular section includes a bypass valve 24; and wherein a radially extending flange 21 provides an anti-drainback valve [as in claim 2].

As for claim 3, upon modification, the clean-side valve would extend transversely across the annular sections [as in claim 3].

Allowable Subject Matter

7. Claims 11-14 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.
8. Claims 8-10 are allowed.
9. The closest cited art—Daniel, Buckman and Hultgren—fail to anticipate or render obvious, alone or in any proper combination, the 3-valve unitary body that includes a radially extending flange having radially extending rib portions thereon that also extend axially on the first annular section but are axially spaced from the annular sealing ring which deflects inwardly when the filter element is clogged—within the inventions of claims 8 and 11.

Response to Arguments

10. Applicant's arguments with respect to claim 1 and its dependents have been considered but are moot in view of the new grounds of rejection. Applicant has amended claim 1, to require that the valve body be unitary and of resilient flexible material and has argued that the claimed invention now requires "a unitary body made of a single piece" (last paragraph of page 9). However, as shown in Buckman, making plural valves of an oil filter into a single piece is known; and as shown in Hultgren, having plural valves of an oil filter to include a clean-side valve is known. Reasons for having the clean-side valve in the oil filter of Buckman was given in section 6 above. Even though the prior art does not anticipate the three valves of claim 1 being a single piece unitary body of flexible resilient material, the examiner contends that such

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would be obvious and within ordinary skill since combining a plurality of valves into single piece to provide the benefits of reduced costs for making and assembling the filter is known—as taught in Buckman; and since it has been decided that making an assembly of parts into one piece is a matter of obvious engineering choice (In re Larson).

Conclusion

11. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (703)305-0079 for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:00a to 4:30p, on at least four days during the week M-F.
- The group receptionist can be reached at (703)308-0661 for inquiries of a general nature or those relating to the status of this or proceeding applications.
- Wanda Walker, the examiner's supervisor, can be reached at (703)308-0457 if attempts to reach the examiner are unsuccessful.
- Fax numbers for this art unit are as follows:
 - i. (703)872-9310 for *official* faxes (i.e. faxes to be entered as part of the file history) that are not after-final; and
 - ii. (703)872-9311 if after-final.

TKC

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March 28, 2003

Joseph D. Dudge
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